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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/822,735 | 03/30/2001 | Jirning Sun | 42390P10450 | 7299 |
| 8791 | 7590 | 08/13/2004 | EXAMINER | |
| BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030 | | | BROWN, JAMES LEE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2144 | |

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,735

Applicant(s)

SUN ET AL.

Examiner

James Brown

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/01/2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This application has been examined.
2. Preliminary amendment to correct claim numbering, received 05/30/2001, has been entered into record. Claims amended: 8, 18, 22-27, 29, and 30.
3. Information Disclosure Statement (IDS), Paper 5, received 08/01/2003, has been entered into record.
4. Claims 1-30 are pending.

Priority

5. No claim for priority has been made in this application.
6. The effective filing date for the subject matter defined in the pending claims in this application is 03/30/2001.

Drawings

7. The Examiner contends that the drawings submitted on 03/30/2001 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-3, 5-13, 15-23, and 25-30 are rejected under 35 U.S.C. §102(e) as being anticipated by Chatterjee et al. (U.S. Patent Pub. US2002/0081027A1) hereinafter referred to as Chatterjee.

10. In regards to claims 1 and 8, Chatterjee disclosed apparatus comprising:
an encoder to encode data having a first format into a string of data having a second format (Sec. 0016, 0018),

the first and second formats being different (Sec. 0016, 0018);

a packetizer coupled to the encoder to packetize the string of data into at least one packet having a header (Sec. 0018 and Fig. 2),

the header identifying the first format (Sec. 0016, 0021);

and a decoder coupled to the packetizer to decode the at least one packet back into the data having the first format (Sec. 0020, 0023, and Fig. 3).

11. In regards to claims 2, and 9-10, Chatterjee disclosed ***wherein the decoder comprises a detector to detect the second format and a converter to convert the string of data back into the data having the first format.*** (Sec. 0023)

12. In regards to claims 3 and 8, Chatterjee disclosed ***at least one packet is transmitted to a network supporting the second format.*** This function is realized because packetized messages may be sent as text in an e-mail message. (Sec. 0016)

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13. In regards to claim 5, Chatterjee disclosed ***wherein the second format is an American Standard Code of Information Interchange (ASCII) format.*** (Sec. 0016, 0018)

14. In regards to claim 6, Chatterjee disclosed ***wherein the data having the first format is ink input data.*** (Sec. 0016)

15. In regards to claim 7, ***wherein the ink input data is obtained from is one of a touch-screen, a digitizer, a tablet, and a mouse.*** The applicant admits "it is well known to capture hand written input in an electronic form by capturing information associated with the movement of an electronic pen on a tablet." (Applicant's Spec. Sec 0026)

16. In regards to claims 11 and 18, Chatterjee disclosed a method comprising:
encoding data having a first format into a string of data having a second format
(Sec. 0016, 0018), ***the first and second formats being different*** (Sec. 0016, 0018);
packetizing the string of data into at least one packet having a header, the header identifying the first format (Sec. 0018 and Fig. 2); ***the network transmitting the packet to a decoder*** (function realized when e-mail recipient recovers encoded ink data from an e-mail message – Sec. 0016)
and decoding the at least one packet back into the data having the first format
(Sec. 0020, 0023, and Fig. 3).

17. In regards to claims 12,19, and 20, Chatterjee disclosed ***wherein the decoding comprises detecting the second format and converting the string of data into the data having the first format.*** (Sec. 0023)

18. In regards to claims 13, Chatterjee disclosed ***wherein the at least one packet is transmitted to a network supporting the second format.*** This function is realized because packetized messages may be sent as text in an e-mail message. (Sec. 0016)

19. In regards to claim 15, Chatterjee disclosed ***wherein the second format is an American Standard Code of Information Interchange (ASCII) format.*** (Sec. 0016, 0018)

20. In regards to claim 16, Chatterjee disclosed ***wherein the data having the first format is ink input data.*** (Sec. 0016)

21. In regards to claim 17, Chatterjee disclosed ***wherein the ink input data is obtained from is one of a touch-screen, a digitizer, a tablet, and a mouse.*** The applicant admits "it is well known to capture hand written input in an electronic form by capturing information associated with the movement of an electronic pen on a tablet."
(Applicant's Spec. Sec 0026)

22. In regards to claims 21 and 28, Chatterjee disclosed a computer program product (Sec. 0016) comprising:

a computer usable medium having computer program code embodied therein, the computer program product having: computer readable program code for encoding data having a first format into a string of data having a second format, the first and second formats being different (Sec. 0016, 0018);
computer readable program code for packetizing the string of data into at least one packet having a header (Sec. 0018 and Fig. 2), ***the header identifying the first format*** (Sec. 0016, 0021);
and computer readable program code for decoding the at least one packet back into the data having the first format (Sec. 0020, 0023, and Fig. 3).

23. In regards to claims 22, 29, and 30, Chatterjee disclosed ***wherein the computer readable program code for decoding comprises computer readable program code for detecting the second format and converting the string of data into the data having the first format.*** (Sec. 0023)

24. In regards to claim 23, Chatterjee disclosed ***wherein the at least one packet is transmitted to a network supporting the second format.*** This function is realized because packetized messages may be sent as text in an e-mail message. (Sec. 0016)

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25. In regards to claims 25, Chatterjee disclosed ***wherein the second format is an American Standard Code of information Interchange (ASCII) format.*** (Sec. 0016, 0018)

26. In regards to claim 26, Chatterjee disclosed ***wherein the data having the first format is an ink-input data.*** (Sec. 0016)

27. In regards to claim 27, ***wherein the ink input data is obtained from is one of a touch-screen, a digitizer, a tablet, and a mouse.*** The applicant admits "it is well known to capture hand written input in an electronic form by capturing information associated with the movement of an electronic pen on a tablet." (Applicant's Spec. Sec. 0026)

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 4, 14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatterjee et al as applied to claims 1-3, 5-13, 15-23, and 25-30 above, and further in view of Herbert, Jr. (U.S. Patent No. 6,741,749) hereinafter referred to as Herbert.

30. Chatterjee teaches encoding and decoding electronic ink data (first format) into ASCII text (second format). Chatterjee also teaches formatting ink data into packets and transmitting ASCII encoded ink data across a network using electronic mail. Chatterjee doesn't specifically disclose apparatus, method, or computer program product "**wherein the network comprises an instant messaging (IM) infrastructure**" (transmitting ink data across an instant messaging infrastructure).

31. Herbert teaches that it is often desirable to capture ink data (handwritten information) so that it may be incorporated into e-mail messages, facsimiles, and instant messages. (Column 5, lines 1-5)

32. It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the teachings of Chatterjee with the teachings of Herbert to expand the number of transport mechanism for transmitting ink data.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Hendricks et al (U.S. Pat. App. Pub. 2003/0163525 A1) teaches a system and method for transmitting ink instant messaging with active annotation.

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- b. Becker et al (U.S. Pat. App. Pub. 2002/0130904 A1) teaches a method and apparatus for communicating graphical and text information.
- c. Ditzik (U.S. Pat. No. 6,415,256 B1) teaches a handwriting recognition system.

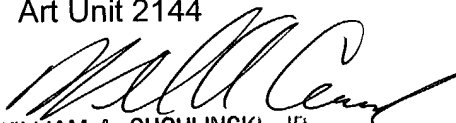
34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Brown whose telephone number is 703-605-4247. The examiner can normally be reached on M-F 8:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jb

James Brown
Examiner
Art Unit 2144


WILLIAM A. CUCHLINSKI, JR.
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